

## REMARKS

This paper is responsive to the final Office Action mailed June 19, 2006. Claims 1-35 are pending in the application and currently stand rejected. In the Office Action, the Examiner indicated that applicants' arguments with respect to Claims 1-35 were considered, but were moot in view of the new grounds for rejection.

In particular, Claims 1-6, 9, 11-16, 19, 21-24, 27, and 29-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0063575, to Kinjo (hereinafter "Kinjo") and U.S. Patent Application Publication No. 2005/0015311, to Frantz et al. (hereinafter "Frantz"). Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinjo and Frantz, and further in view of U.S. Patent No. 6,611,881, to Gottfurcht et al. (hereinafter "Gottfurcht"). Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinjo and Frantz, and further in view of U.S. Published Patent Application No. 2002/0107861, to Clendinning et al. (hereinafter "Clendinning"). Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kinjo and Frantz, and further in view of U.S. Patent No. 5,818,028, to Meyerson et al. (hereinafter "Meyerson") Additionally, Claims 12 and 15-28 were rejected under the same rationale as Claims 1-11, 13, 14, and 29-35 as having similar limitations.

Applicants have carefully considered the prior art and the comments provided in the Office Action, and respectfully submit that the claims of the present application are patentable over cited art, whether considered alone or in any motivated combination. Withdrawal of the claim rejections and allowance of the application is proper.

### Interview Summary

Prior to discussing the prior art and the patentability of the claims, the undersigned counsel wishes to thank Examiner Serrao for the time and consideration he extended in a

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telephonic interview conducted August 19, 2006. The interview, in summary, focused principally on independent claims 1, 12, 22 and 30, with proposed amendments, in view of the teachings of Kinjo and Frantz. Applicants agreed to submit the present response, after which the examiner would further consider the allowability of the claims. As discussed below, the distinctions in the claims are important and patentably define the claims over the cited art.

### The Present Application

The present application describes technology that provides useful competitive purchasing information to consumers while the consumers remain present at a first retail location.

In one exemplary embodiment, a user is able to obtain information associated with a selected item by using a portable imaging device, such as a digital camera, mobile telephone, portable computing device, etc., that has a component capable of capturing an image. A user present at a location of a first retail entity (*e.g.*, a brick-and-mortar retail store) obtains an image that contains identifying data associated with an item as provided by the first retail entity. The identifying data for the item is extracted from the image and is used to obtain information related to the item from a second retail entity that is different than the first retail entity. The item information is then communicated from the second entity to the imaging device for delivery to the user, while the user remains present at the location of the first retail entity.

In accordance with another aspect, data received from a number of different portable imaging devices is collected and processed to facilitate sales forecasting analysis. Data is collected when users of the portable imaging devices submit images requesting information for an item. The collected data (*e.g.*, the number of times an image for an item has been received from different imaging devices) may be used to generate sales forecasting reports to determine market demand for various items. Such reports may assist merchants in accurately forecasting future purchasing activity for products or other items.

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U.S. Patent Publication No. US 2003/0063575 (Kinjo)

Kinjo is directed to an order processing apparatus for ordering an object featured in a displayed image. In one embodiment, a consumer watching television may photograph an object displayed on a television screen using a portable device. The image, together with information representing an order for the object, is sent from the portable device to the order processing apparatus. The object is identified by comparing the sent image with an original television image as broadcast and the order for the object is processed. In another embodiment, a customer can order an article from a store by photographing the article in the store and having the order processed at the store (See the Abstract, and paragraphs [0009]-[0010] and [0133] in Kinjo).

U.S. Patent Publication No. US 2005/0015311 (Frantz)

Frantz is directed to a system and a method for placing orders utilizing barcode scanning technology. A user scans barcodes for all the objects that he or she wishes to order and uploads this information to a computer operated by the user. As described by Frantz, the user's computer is equipped with a necessary software application that processes this barcode information.

The software application assigns each barcode to a particular "preferred" vendor and creates a shopping cart list corresponding to each vendor. Each of the barcodes is checked to see if the object is located in a first preferred vendor product database. For barcodes not found in the first preferred vendor database, the software searches a second preferred vendor database and so on.

The software application then creates shopping cart lists corresponding to the preferred vendors and sends each of the lists, properly formatted, to the respective vendors. A Web browser is opened for the user to display the shopping cart for each vendor populated with the uploaded items. (Frantz, Abstract, paragraphs 0041-0044.) Frantz thus asserts an advantage in that the software application running on the user's computer can process the barcode information

and prepare a shopping cart list suitable for multiple Web vendors. The vendors are not required to have any special software for processing images of products, nor must the vendors even know that the shopping cart lists they receive come from a user program that prepared the shopping lists from product barcodes.

#### Claim Rejections Under 35 U.S.C. § 103(a)

A prima facie case of obviousness under 35 U.S.C. § 103 requires three basic criteria to be met: the prior art references must teach or suggest all the claim limitations; there must be a reasonable expectation of success to combine the reference teachings; and there must be some suggestion or motivation to combine the reference teachings, either in references themselves or in the knowledge generally available to one of ordinary skill in the art at the time the invention was made. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). *See also*, MPEP § 706.02(j) and MPEP § 2143-§ 2143.03. Moreover, the teaching or suggestion to make the claimed determination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *Id.*

The analysis below shows that Kinjo and Frantz fail individually and collectively to teach all the elements of independent Claims 1, 12, 22, and 30 of the present application, nor is there a proper motivation in the prior art to combine the references. Moreover, the remaining cited references (Gottfurcht, Clendinning, and Meyerson) fail to overcome the deficiencies of Kinjo and Frantz.

#### I. Independent Claim 1

Claim 1 is directed to a method for communicating information regarding a selected item to a user present at the location of a first retail entity. The method comprises, in part, "while the user remains present at the location of the first retail entity, which first retail entity is different than a second retail entity, the second retail entity: ... using the identifying data to obtain item

information associated with the selected item." These elements are not taught or suggested by Kinjo, as was acknowledged in the Office Action. Frantz, however, also fails to teach these elements, even if combined with Kinjo.

According to Frantz, a user scans desired barcodes and then uploads the barcodes to a computer operated by the user. (Frantz, paragraphs [0014] and [0034]). The user thereafter accesses the computer and launches a software application as disclosed by Frantz. (Frantz, paragraphs [0016] and [0046].) The user interacts with the software application to prepare and send shopping lists to preferred vendors to order the products represented by the barcodes. (Frantz, paragraphs [0016] and [0018]. See also [paragraphs [0037], [0040]-[0041], and [0043].)

Frantz does not teach that a user would scan a barcode while being present at a location of a first retail entity. Regardless, for purposes of thorough consideration, even if the user scans a barcode while at the location of a first retail entity, the disclosure of Frantz thereafter requires the user to proceed to the location of his or her computer that has been configured to execute the software application disclosed by Frantz. (Frantz, paragraphs [0038] and [0050]). Notably, Frantz does not teach a system in which a user has brought a computer into the location of a first retail entity and then uploads barcode information to the computer, nor is there any motivation in Frantz to do so. Indeed, even where Frantz teaches a wireless connection to upload barcode information to the computer (Frantz, paragraph [0034]), Frantz does not suggest that the user has brought the computer with him or her to the location of a first retail entity.

If the computer is located at the second retail entity or at the user's place of business, for instance, Frantz still fails to teach "while the user remains present at the location of the first retail entity...using the identifying data to obtain item information associated with the selected item," as recited in Claim 1. It is improper to divide this element and state that Kinjo teaches the first part ("while the user remains present at the location of the first retail entity") and Frantz teaches

the second part ("using the identifying data to obtain item information associated with the selected item"), because there must be a motivation to combine the two disclosures. Here, Frantz teaches away from "using the identifying data," as claimed, "*while the user remains present at the first retail entity*," because Frantz teaches uploading the barcode information to a computer, after which the user must be present at the computer to execute the software disclosed by Frantz to prepare shopping cart lists for the various vendors.

Perhaps more noticeably absent in Frantz is the feature in which the method elements of receiving an image from the user, extracting identifying data from the image, using the identifying data to obtain item information, and communicating the item information to the imaging device for delivery to the user, as claimed, are *performed by a second retail entity* that is different than the first retail entity. Neither Frantz nor Kinjo teach a second retail entity that performs the elements of the method. Kinjo does not mention a second retail entity, and to the extent Frantz teaches communication with a vendor, the communication is to submit a shopping cart list to the vendor.

Claim 1 further recites, in part, "while the user remains present at the location of the first retail entity...communicating the item information from the second retail entity to the imaging device for delivery to the user." Again, the Office Action acknowledged the deficiency of Kinjo and turned to Frantz to supply the missing disclosure. However, the Office Action is again mistaken in this regard. According to Frantz, the software application that the user is executing on his or her computer prepares shopping lists in XML format and submits the lists to respective preferred vendors. To the extent a vendor is equated with a "second retail entity" as claimed, applicants note that item information is not being communicated from the second retail entity to the imaging device of the user; instead, the user's shopping lists are being communicated from the user's computer to the second retail entity. (Frantz, Figure 2, item 209; Figure 3, item 313).

Applicants further note that Frantz does not teach or suggest communicating the item information from the second retail entity *to the imaging device* for delivery to the user. Frantz explicitly teaches that the computer 109 is separate and different from the scanner 105. (See Frantz, Figure 1 and paragraph [0034]).

Applicant further submits that the disclosures of Kinjo and Frantz would not be combined as there is no motivation to do so. Frantz explicitly teaches a system in which a user's computer is configured with a software application that prepares shopping cart lists properly formatted for uploading to vendors. An advantage obtained by Frantz is that the vendors are not required to have any special software for processing images of products, nor must the vendors even know that the shopping cart lists they receive come from a user program that prepared the shopping lists.

It would be contrary to the teachings of Frantz to suggest, in hindsight of the present invention, that Frantz could be modified to communicate a product image to a second retail entity for processing by the second retail entity. Kinjo teaches a system in which a user can order a product from a store using an image of the product, but there is nothing in Kinjo to suggest that the image should be communicated to a second retail entity.

These distinctions are important and lead to the patentability of Claim 1. Even if the respective disclosures of Kinjo and Frantz are somehow combined, the combination still fails to teach all of the elements of Claim 1. Applicants therefore request withdrawal of the rejection of Claim 1.

## II. Dependent Claims 3 and 7

Claim 3 depends from independent Claim 1 and is believed to be patentable for at least the same reasons as Claim 1. It is further submitted that Claim 3 is patentable for at least the following additional reasons.

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The Office Action asserts that Kinjo (paragraph [0058]) teaches the elements of Claim 3, namely, the method of Claim 1 further comprising outputting the item information on an audio speaker of the imaging device when the item information is communicated from the second retail entity to the imaging device. However, paragraph [0058] of Kinjo simply cites an audio speaker as being a part of the portable device shown in Figure 1 of Kinjo. Kinjo fails to teach the "outputting the item information on an audio speaker of the imaging device when the item information is communicated from the second retail entity to the imaging device" in paragraph [0058] or elsewhere in the publication. Frantz is unavailing because Frantz fails to teach outputting the item information on an audio speaker *of the imaging device*. For these additional reasons, Claim 3 is allowable over Kinjo and Frantz.

Claim 7 recites the method of Claim 1, wherein the method further comprises "compiling historical data based on a number of times an image has been received from different imaging devices, said image containing identifying data associated with the selected item; using the historical data to estimate consumer demand for the selected item; and generating a report that forecasts future purchasing activity for the selected item based on the estimated consumer demand." The Office Action rejected Claim 7 as being unpatentable over a combination of Kinjo, Frantz, and Gottfurcht. While applicants do not agree that these references can be properly combined, the disclosure of Gottfurcht does not overcome the above-noted deficiencies of Kinjo and Frantz. Even if combined, Kinjo, Frantz and Gottfurcht do not teach all of the elements recited in Claim 7. Kinjo does not teach any action or analysis based on the "number of times an image has been received from different imaging devices," nor does Frantz. Gottfurcht teaches a conventional system that observes activity of a user to predict user interests, but there is no basis to state that this teaches "compiling historical data based on a number of times an image has been received from different imaging devices," as claimed.



The cited references do not support a *prima facie* obviousness rejection of Claim 7. The rejection should be withdrawn.

### III. Dependent Claims 2, 4-6 and 8-11

As discussed above, the combination of Kinjo and Frantz fails to teach each and every element of independent Claim 1. Dependent Claims 2, 4-6, and 8-10 ultimately depend from independent Claim 1. Accordingly, Claims 2, 4-6, and 9 are likewise allowable over Kinjo combined with Frantz. Claims 8 and 10 are allowable over Kinjo combined with Frantz, and further in view of Clendinning and Meyerson respectively. The Clendinning and Meyerson references fail to cure the deficiencies noted above in Kinjo and Frantz. Claim 11 has been canceled as Claim 1 has been amended to include the elements of Claim 11.

### IV. Independent Claim 12

Claims 12 and 15-28 were rejected under the same rationale as Claims 1-11, 13, 14, and 29-35 as having similar limitations. (Office Action, p. 10.)

In view of the above analysis of Claim 1, applicants respectfully submit that Kinjo and Frantz fail to teach the all of the elements of Claim 12. In particular, neither Kinjo nor Frantz teach a server comprising "a subsystem configured to communicate the item information to the imaging device for delivery to the user while the user remains present at the location of the first retail entity," especially in light of the feature that states that the server is "operated by a second retail entity that is different than the first retail entity." At best, Kinjo teaches communication between a portable device and a computer operated by a first retail entity, while in Frantz, the computer 109 is operated by the user.

Frantz and Kinjo also fail to teach "a server operated by a second retail entity" having "a subsystem configured to receive an image from the user using the imaging device."

Similar to the analysis of Claim 1, the disclosures of Kinjo and Frantz, alone or in combination, fail to teach all of the elements of Claim 12. Accordingly, Claim 12 is allowable over the cited art.

#### V. Dependent Claims 13-21

Dependent Claims 13-21 ultimately depend from independent Claim 12. As discussed above, the combination of Kinjo and Frantz fails to teach each of the elements of independent Claim 12. Additionally, Claim 17, like Claim 7, presents subject matter that is separately patentable over the prior art. For the above-mentioned reasons, Claims 13-21 are likewise allowable over Kinjo and Frantz.

#### VI. Independent Claim 22

Claim 22 recites elements similar to those of Claim 1. Specifically, based on the above analysis of Claim 1, applicants respectfully submit that Frantz and Kinjo both fail to teach all of the elements of Claim 22. In particular, Frantz and Kinjo both fail to teach "communicating the item information to the imaging device while the user remains present at the location of the first retail entity." For this reason, the rejection of Claim 22 should be withdrawn.

To further distinguish Claim 22 over the cited art, Claim 22 has been amended to recite that the computer-executable component for communicating item information for a selected item is "executed by a second retail entity that is different than a first retail entity." This is not taught or suggested in the cited art. The computer 109 taught by Frantz is not operated by a second retail entity; rather, the computer 109 is operated by the user. Kinjo as well does not teach or suggest a computer-executable component "executed by a second retail entity that is different than a first retail entity," as claimed.

Accordingly, amended Claim 22 is allowable over the prior art.

#### VII. Dependent Claims 23 and 25

Claim 23 depends from independent Claim 22 and is believed to be patentable for at least the same reasons as Claim 22. It is further submitted that Claim 23 is patentable for the reasons discussed above in subsection II. Specifically, Kinjo and Frantz both fails to teach the element of Claim 23 that recites communication of the item information "in a format that enables an audible output of the item information through a speaker." Therefore, Claim 23 is allowable over Kinjo and Frantz.

Claim 25 depends from independent Claim 22 and is patentable for at least the same reasons as Claim 22. Additionally, Claim 25 recites subject matter that is separately patentable, as discussed above in subsection II relative to Claim 7. Specifically, the cited art fails to teach the element of "compiling historical data based on a frequency of receipt of images from different imaging devices," as claimed. Therefore, Claim 25 is allowable over the cited art.

#### VIII. Dependent Claims 24 and 26-29

Dependent Claims 24 and 26-29 depend from independent Claim 22. As discussed above, the combination of Kinjo and Frantz fails to teach each of the elements of independent Claim 22. Accordingly, for the above-mentioned reasons, Claims 24 and 26-29 are likewise allowable over Kinjo and Frantz.

#### IX. Independent Claim 30

The Office Action acknowledged that Kinjo fails to teach the elements of: an output device for outputting item information for the selected item as obtained from a second retail entity that is different from the first retail entity; the output device and the storage medium for executing the program instructions that process the image by obtaining the item information for the selected item by communicating the image containing the identifying data to the second retail entity; and outputting on the output device the item information obtained from the second retail

entity, wherein the output device communicates the item information to a user and wherein the item information enables the user to request the item from the second retail entity while the user remains at the location of the first retail entity. (Office Action, p. 5-6). However, the Office Action asserted that Frantz teaches the above elements in paragraphs [0041], [0016], and [0018]. (Office Action, p. 6.) Applicants respectfully disagree.

Claim 30 claims an integrated portable apparatus for obtaining item information for a selected item at a location of a first retail entity. The apparatus comprises, among other things, an input device for capturing an image of the selected item and an output device for outputting item information for the selected item as obtained from a second retail entity that is different than the first retail entity. As the Office Action acknowledged, Kinjo fails to teach the output device as claimed. (Office Action, p. 5.) However, the output device taught by Frantz (the computer 109) cannot be integrated with the input device (scanner 105) because, as the element suggests, the integrated apparatus must include both an input and output device, wherein the output device communicates item information obtained from the second retail entity. The computer taught by Frantz is separate from the scanner. This distinction is further accentuated by the fact that Frantz requires a communication link (wired or wireless) to upload scanned barcode information to the computer 109.

Additionally, Claim 30 recites, in part, "obtaining the item information for the selected item by communicating the image containing the identifying data to the second retail entity." There is no disclosure in Frantz that teaches or suggests this element. At best, Frantz teaches communicating a shopping list to a preferred vendor, wherein the shopping list is supplied in a format such as XML. Frantz does not suggest that the image captured by the input device (i.e., scanner 105) is communicated to the preferred vendor. Kinjo, for its part, also does not teach or suggest "communicating the image containing the identifying data to [a] second retail entity."

Thus, the combination of the teachings of Kinjo and Frantz cannot produce any meaningful result that would render Claim 30 obvious. For the above reasons, as well as the reasons presented with respect to Claim 1, applicants submit that Claim 30 is patentable over the cited art.

X. Dependent Claims 31-35

Dependent Claims 31-35 depend from independent Claim 30. As discussed above, the combination of Kinjo and Frantz fails to teach each of the elements of independent Claim 30. Accordingly, Claims 31-35 are likewise allowable over Kinjo combined with Frantz.

CONCLUSION

In view of the foregoing claim amendments and remarks, applicants submit that all of the pending claims in the application are in condition for allowance. Reconsideration of the application and allowance of the claims is solicited. If the Examiner has any remaining questions or comments concerning this matter, the Examiner is invited to contact applicants' undersigned attorney at the number provided below.

Respectfully submitted,

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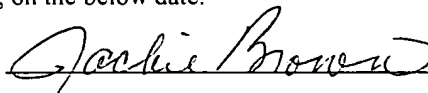
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